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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S POST-HEARING REPLY BRIEF MOTION FOR RECONSIDERATION AND CLARIFICATION OF THE JULY 12, 2004 MARKMAN ORDER RE THE TERM "IDENTIFICATION ENCODER"** **DATE:** September 8-9, 2005 **TIME:** 9:00 a.m. **CTRM:** Hon. James Ware

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I. INTRODUCTION

This reply brief organizes the live testimony of Merrill Weiss with the corresponding legal issues, responds to defendants' legal contentions, and brings to the Court's attention new and controlling decisional authority from the Federal Circuit relating to the issues of indefiniteness and claim construction.

In its Motion for Reconsideration, Acacia asks the Court to construe the claim term "identification encoder" of the '702 patent to mean "a structure that assigns a unique identification code." As demonstrated by the live testimony of Mr. Weiss, a person of ordinary skill in the art in 1991 would have understood the term "identification encoder" to include the mandatory function of assigning a unique identification code to items in the transmission system, when reading the claims and specification of the '702 patent and in light of that person's understanding of the meaning of such terms in the field of art at that time.

This construction is not overly broad or impermissibly "functional," as defendants contend. In other cases involving claim terms which do not connote a specific structure, but which would have been understood to describe structure (such as, "digital detector," "baffles," and "connector assembly"), the Federal Circuit has construed such terms in such a manner that they would encompass a multitude of structures. Such broad constructions did not concern the Federal Circuit, because the claim term was understood by persons skilled in the art to describe structure. In this case, the term "encoder" in the phrase "identification encoder" would have been understood by persons skilled in the art to connote structure.

II. THE COURT SHOULD CONSTRUE THE TERM "IDENTIFICATION ENCODER" TO MEAN "A STRUCTURE THAT ASSIGNS A UNIQUE IDENTIFICATION CODE"

Based on the Court's comments at the hearing, this motion for reconsideration only involves the issue of the proper construction of the claim terms; it does not involve a motion to invalidate claims under 35 U.S.C. § 112, ¶¶ 1 or 2. (Sept. 8, 2005, Transcript, at 61:13-21).

The task for the Court when construing any patent claim term is to determine the meaning that the claim term would have had to a person of ordinary skill in the art at the time of the invention. *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1116

(Fed. Cir. 2004) ("A court construing a patent claim seeks to accord a claim the meaning it would have to a person of ordinary skill at the time of the invention.") "[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification" and is deemed to read the claim term with an understanding of the meaning and usage of such terms in the field. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (2005), *quoting*, *Multiform Disiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) ("It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field.")

When determining the meaning that the claim term would have had to a person of ordinary skill in the art at the time of the invention, a court may consider extrinsic evidence of the usage and meaning of a term in the context of the invention. Although the Federal Circuit in *Phillips* instructed courts to use caution when considering extrinsic expert testimony to assist with construing claim terms, the court did not preclude its use and, in fact, stated that extrinsic expert testimony can help a district court determine what a person of ordinary skill in the art would have understood claim terms to mean. *Phillips*, 415 F.3d at 1319 ("Nonetheless because extrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean, it is permissible for the district court in its sound discretion to admit and use such evidence.")[1]

In its Markman Order, the Court, based solely on the intrinsic patent documents, construed the term "identification encoder" to mean "a structure that assigns a unique identification code," but also stated that the term "identification encoder" was arguably indefinite.[2] (Markman Order, at 35:24 – 36:1). Although the Court also stated in the Markman Order that it "declines to address further the issue of indefiniteness during claim construction," the Court invited defendants to file a motion for summary judgment under 35 U.S.C. § 112, ¶¶ 1 and 2." (Markman Order, 36:2-3). The Court also stated that it would not rule on the validity of the claims under 35 U.S.C. § 112, ¶ 6 until the parties have had an opportunity to present expert testimony. (Markman Order, at page 21, n 16).

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[1] *See also, Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed. Cir. 2002) ("While reference to intrinsic evidence is primary in interpreting claims, the criterion is the meaning of words as they would be understood by persons in the field of the invention. Patent documents are written for persons familiar with the relevant field; the patentee is not required to include in the specification information readily understood by practitioners, lest every patent be required to be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Thus resolution of any ambiguity arising from the claims and specification may be aided by extrinsic evidence of usage and meaning of a term in the context of the invention.")

Accordingly, at the September 8-9 hearing, Acacia presented the live expert testimony of Mr. S. Merrill Weiss to assist the Court with understanding how a person of ordinary skill in the art in January 1991 would have understood the claim term "identification encoder." In contrast, no defendant presented the live testimony of any expert, even though defendants had retained Dr. Andrew Lippman of the MIT Media Lab for this purpose and even though the Court had sought expert testimony from the parties. Instead, defendants stated that they would rely on Dr. Lippman's declaration filed with defendants' oppositions to Acacia's motion for reconsideration. Dr. Lippman's declaration is inadmissible hearsay and the Court should not admit it into evidence or consider it in any way. Acacia discusses Dr. Lippman's declaration in its accompanying reply brief re: the exclusion of the hearsay expert declarations of Dr. Lippman.

A. The Live Expert Testimony Of Mr. Weiss Supports Construing The Term "Identification Encoder" As "A Structure That Assigns A Unique Identification Code"

1. Mr. Weiss Testified That One Of Ordinary Skill In The Art In 1991 When Reading The Claims In Light Of The Specification Would Have Understood What Was Meant By The "Identification Encoder" In The Claims

Consistent with the long-standing use of expert testimony recognized by the Federal Circuit and confirmed in *Phillips*, Mr. Weiss provided the Court with background on the technology, an understanding of the technical aspects of the invention, and the meaning of claim terms in the pertinent field. As shown below, Mr. Weiss supported his opinion with his reading of the patent

[2] At the hearing, the Court stated that it believed that the definition that it had given for "identification encoder" in the Markman Order was "a functional definition that it was dissatisfied with as being a definite enough characterization." (*See*, Sept. 9, 2005, Transcript, at 256:15 – 257:8).

claims and specification, with information that persons of ordinary skill in the art would have known in 1991, apart from the patent, and with examples from Mr. Weiss' own experiences.[3]

Mr. Weiss explained that the term "identification encoder," apart from the patent, would have had meaning to a person of ordinary skill in the art in 1991, because the terms "identification" and "encoder" had meanings. The term "encoder" referred to "a device that applies a coding rule or algorithm that accepts an input, applies the rule, and then produces an output. (Weiss, Sept. 8, 2005, at 69:13-21). "The term 'identification' would certainly be understood as saying that the encoder was in some way helping to identify things." (Weiss, Sept. 8, 2005, at 73:3-21).

Mr. Weiss also discussed the fact that persons of ordinary skill in the art in 1991 would have understood the concept of unique identification codes and would have understood in 1991 that there were two primary characteristics to unique identification codes – the scope and quality of uniqueness. (Weiss, Sept. 8, 2005, at 121:6 – 124:5). Mr. Weiss also described the fact that persons of ordinary skill in the art would have understood the unique identifier to relate to computer databases and described the "primary key" technique that was in use in 1991, including the broadcast industry. (*Id.* at 124:22 – 127:2). Mr. Weiss also described his own experiences prior to 1991 in which he employed unique identifiers. (*Id.* at 127:3 – 128:9).

Mr. Weiss also provided the Court with guidance as to what the hypothetical person of ordinary skill in the art in January 1991, when reading the '702 patent, would have understood what was meant by the term "identification encoder." (Weiss, Sept. 8, 2005, at 63:14-23; 128:10-23). When considering the term "identification encoder" within the scope of the patent, Mr. Weiss explained that claim 1 describes a function of the identification encoder and that this function is

[3] The Federal Circuit recently held that an expert's testimony which merely cited passages from the patent specification and reached a conclusion was not supported and was conclusory, because the expert did not support his testimony with any references to industry publications or other independent sources. *Network Commerce, Inc. v. Microsoft Corp.*, __ F.3d __, 2005 U.S. App. LEXIS 19355, at *18-19 (Fed. Cir. 2005) (Exhibit 1). Mr. Weiss provided independent support for his testimony through examples of knowledge that persons of ordinary skill in the art would have had in 1991 and Mr. Weiss' own experiences prior to 1991. Mr. Weiss' testimony was therefore neither conclusory nor unsupported, as defendants contended at the hearing.

providing a unique identification code to items in the compressed data library.[4] (Weiss, Sept. 8, 2005, at 74:25 – 75:10). Claim 27 also describes another function of the "identification encoder," allowing entry of a popularity code.[5] (*Id.* at 76:16-20).

Mr. Weiss explained that the inputs, functions, and outputs of the identification encoder would have been understood by persons of ordinary skill in the art in 1991 from the specification of the '702 patent. (Weiss, Sept. 8, 2005, at 86:22 – 120:20). The input to the identification encoder is the retrieved information from the source material library and the data that may be input by the system operator. (*Id.* at 87:6-20; 103:10 – 104:6; 117:25). These inputs may vary depending upon where in the system the identification encoder is placed. (*Id.* at 118:1-19).

A mandatory function of the identification encoder is applying a unique identification code to the item.[6] (*Id.*, at 88:23 – 91:14; 118:20 – 119:5). Other optional functions of the identification encoder are also described in the specification, such as logging details about the item, program notes, assigning a file address, assigning a popularity code, providing copy protection, and mapping item names to item addresses. (*Id.* at 92:11-93:4; 93:21 – 94:7; 101:7-19; 108:16 – 109:11; 119:6-8).

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[4] Defendant Comcast contends that the fact that claim 1 recites the term "identification encoder" and additionally states that "the identification encoder gives items in the compressed data library a unique identification code" means that assigning a unique identification code to items in the compressed data library is not an inherent function of an "identification encoder." (Comcast Opposition, at 13:1-15). Acacia contends that the "identification encoder" should be construed as "a structure that assigns a unique identification code." It is *not* inherent in this construction that the identification encoder assigns a unique identification code to the *items in the compressed data library*. Thus, the additional language in the claim which specifies that the identification encoder assigns the unique identification code to items in the compressed data library would not cause this phrase in the claims to be redundant of the term "identification encoder" in claim 1.

[5] Defendant Comcast contends that claim 17, which is silent as the function of the "identification encoder," causes more confusion as to the meaning of "identification encoder." (Comcast Opposition, at 13:16 – 14:3). Comcast contends that one skilled in the art would not know which function of the identification encoder would be covered by this use of "identification encoder." Mr. Weiss' testimony, however, establishes that the only mandatory function of the identification encoder that is described in the patent specification is assigning a unique identification code. (Weiss, Sept. 8, 2005, at 88:23 – 91:14; 118:20 – 119:5). Comcast wonders whether the function of the identification encoder in claim 17 could be copy-protection or assigning a unique address code, but these functions are merely optional functions of the identification encoder. Neither of these functions are "identifying" functions. The claim term is "*identification* encoder" and the patentees' use of the term "identification" would communicate to persons of ordinary skill in the art that the "identification encoder" must at least have the function of identifying. Acacia therefore did not merely "select" this function, as EchoStar implies. (EchoStar Opposition, at 15:13-15).

[6] Mr. Weiss explained that persons of ordinary skill in the art in 1991 would have understood that the unique identification code is assigned to the item because, in the context of the patent, there would be many items stored in the library and there needs to be a way of identifying it and telling it apart from all of the others. (Weiss, Sept. 8, 2005, at 91:22 – 92:8). Mr. Weiss also stated that the storage of files in libraries was well-known in 1991 and that the use of unique identification codes to make files addressable was also well-known in 1991. (*Id.* at 102:15-23).

The outputs of the identification encoder are the item, which, if digital, is output to the digital input receiver, and, if analog, is output to the analog to digital converter, and the information about the item, which is output to the item database or is kept with the item, associated with the file. (*Id.* at 94:9 – 96:6; 110:14 – 112:24; 119:9 – 120:21).

Mr. Weiss summarized his findings from the specification of the '702 patent in a list which he presented during his testimony. (Exhibit 5).

When asked whether one of ordinary skill in the art in 1991, knowing everything taught in the '702 patent about the identification encoder, would have understood the identification encoder as assigning a unique identification code, Mr. Weiss stated that he would also include information about the input, the output, and the variety of functions that are possible within the identification encoder.[7] (Weiss, Sept. 8, 2005, at 143:24 – 144:13).

Lastly, Mr. Weiss explained that the person of ordinary skill in the art in 1991 could have made and used the identification encoder of the '702 patent without undue experimentation.[8] (Weiss, Sept. 8, 2005, at 144:14 – 146:9).

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[7] Mr. Weiss also stated that the understanding of the person of ordinary skill in 1991 of the term "identification encoder" was the "definition that I wrote out in my declaration." (Weiss, Sept. 8, 2005, at 143:9-17).

[8] At the end of his testimony, the Court asked Mr. Weiss whether multiple engineers, when given the term "identification encoder" and the disclosure in the specification, would come up with multiple solutions for the "identification encoder." (Weiss, Sept. 8, 2005, at 247:9-13). Mr. Weiss said that:

> There certainly are multiple ways that, that individual applications would have devised the actual functioning of the identification encoder. I think I said yesterday that the system would need to be designed very specifically for an application, and I talked yesterday about the scope of the identifier, for instance. The characteristics of the system would lead to different specific designs, I believe, of the identification encoder. But the fundamental functions that are required are defined in the patent.

(Weiss, Sept. 9, 2005, at 247:14 – 248:1).

Thus, Mr. Weiss' expert testimony is consistent with and is well-supported by the intrinsic patent evidence, including the patent claims and the specification. Based on Mr. Weiss' discussion at the hearing regarding the knowledge of persons of ordinary skill in the art in 1991 apart from the patent and his guidance as to the meaning of "sequence encoder" to persons of skill in the art when reading the '702 patent, it is evident that a person of ordinary skill in the art in 1991 would have understood the meaning of the claim term "identification encoder" and would have understood the inputs, outputs, and functions (both mandatory and optional) of the identification encoder, which were disclosed in the patent specification. Thus, because the term "identification encoder" would have been understood by persons of ordinary skill in the art in 1991, the Court should construe the term "identification encoder" as "a structure that assigns a unique identification code."

B. The Differences Between Mr. Weiss' Definition Of "Identification Encoder" And Acacia's Proposed Construction Are Immaterial And Irrelevant

Defendants have contended that the differences between Mr. Weiss' definition of "identification encoder" to one of ordinary skill in the art and Acacia's proposed construction are evidence of indefiniteness of "identification encoder." They are not.

Acacia proposes that the Court construe "identification encoder" to be "a structure that assigns a unique identification code."

In his declaration, Mr. Weiss defined "identification encoder" to one of ordinary skill in the art in 1991 as follows:

> 62. Given all of the preceding, I conclude that one of ordinary skill in the art in January, 1991, would have understood the meaning of the term Identification Encoder. That person would have understood it to be a computer program or routine, running on either standard or specialized computer hardware, that assigned a unique identification code to each content item in such a way as to differentiate it from all other such content items on the system and to allow its processing and retrieval in conjunction with the other elements described in the patent.
>
> 63. The person of ordinary skill in the art would have understood the Identification Encoder to have an input, for example, from a source material library; to have at least the function of assigning unique identification codes to the information obtained from material stored in a source library or other source of information, along with numerous other possible functions; and to have an output that provides information, for example, to a conversion means, to a digital input formatter for digital source data, to an analog-to-digital converter for analog source data, or directly to a compressed data formatter for previously compressed information. There is no question in my

> mind that the person of ordinary skill in the art in January, 1991 would have found the Identification Encoder to be understandable as described in the '702 patent.

(Weiss Declaration, October 20, 2004, at ¶¶ 63-64).

At the hearing, Mr. Weiss defined the "identification encoder" to one of ordinary skill in the art as follows:

> MR. DORMAN: Okay. If I asked you, okay, the same question and rather if I asked you a new question that said would that hypothetical person, assuming he knew everything that you testified to in the patent described and understood an identification encoder simply to be a structure that [assigns] a unique identification code, would you disagree with that?
>
> MR. WEISS: That would be a lot more than that.
>
> MR. DORMAN: What else would be in it?
>
> MR. WEISS: The description would include information about the input and it would include information about the output and it would include information about the variety of functions that are possible within the identification encoder.

(Weiss, Sept. 8, 2005, at 143:24 – 144:13).

There are differences between Acacia's proposed construction and Mr. Weiss' definition, because Acacia's proposed construction is how Acacia believes that the *Court* should construe the term in the patent, whereas Mr. Weiss' testimony is how *a person of ordinary skill in the art* would have understood the term in the context of the patent. The two are not the same, as the Court recognized at the hearing. During an exchange with counsel, the Court stated that it would not permit Mr. Weiss to testify as to what he believes the term "identification encoder" means in the patent, because that would invade the province of the Court. (Sept. 8, 2005, Transcript, at 136:12-15). The Court, however, allowed Mr. Weiss to testify as to the meaning that the term would have to one of ordinary skill in the art in 1991 in the context of the patent. (Sept. 8, 2005, Transcript, at 136:24 – 137:3).

There are similarities between Acacia's proposed construction and Mr. Weiss' definition. Both include the mandatory function of the "identification encoder;" i.e., assigning a unique identification code.

One of the differences between Acacia's proposed construction and Mr. Weiss' definition is caused by the claim construction rule that a court should not import a limitation from the specification into the claim. Acacia and Mr. Weiss differ regarding the identification of the inputs and outputs of the "identification encoder" and the optional functions of the "identification encoder." Acacia does not include the inputs, outputs, or optional functions in its proposed construction. Mr. Weiss mentions the inputs, outputs, and possible other functions in his definition, however, Mr. Weiss *never* identifies in his definition any specific input or output or any specific optional function. Mr. Weiss merely provides *examples* of potential inputs and outputs and merely states that the other functions are "possible" functions. This is because the structural input to the "identification encoder" and the structural output from the "identification encoder" will *vary* depending on where in the system the identification encoder is placed. (*See*, Weiss, Sept. 8, 2005, at 118:1-19; '702 patent, 6:39-42). The optional functions of the "identification encoder" will also vary depending on the particular system and the features of that system. (*See, e.g.,* Weiss, Sept. 9, 2005, at 247:14 – 248:1). Thus, the claim construction of "identification encoder" should not include the identity of any specific input or output of the identification encoder or any optional function(s) of the identification encoder, because their inclusion would improperly import limitations from the specification into the claims.

Mr. Weiss also specifically identifies the *type* of structure for the identification encoder as "a computer program or routine, running on either standard or specialized computer hardware." There is no reason why the Court could not replace the term "structure" in the definition of "identification encoder" with Mr. Weiss' words – "a computer program or routine, running on either standard or specialized computer hardware" – if that would give the Court more comfort regarding the specificity of the structure for the construction of "identification encoder."

C. The Fact That The Identification Encoder May Be Construed Broadly Or Functionally Is Not A Ground For Indefiniteness

Defendant Comcast contends that Acacia's proposed construction for the "identification encoder" as "a structure that assigns a unique identification code" is overly broad and "purely functional claiming." (Comcast Opposition, at 12:3-13:1). Comcast cites *Halliburton Oil Well*

Cementing Co. v. Walker, 329 U.S. 1, 12 (1943) as support for this contention. In *Halliburton*, however, unlike the present case, the claim at issue was for "means associated with said pressure device for tuning said receiving means. . ." *Halliburton*, 329 U.S. at 8. That claim language, which is in means-plus function form, caused Congress to pass 35 U.S.C. § 112, ¶ 6. Neither *Halliburton* nor Section 112, ¶ 6 have any application to this case. The claim term in this case does not use the term "means," but instead refers to a structure; i.e., an encoder. The Court has already held that the "identification encoder" is not to be construed under Section 112, ¶ 6 and no defendant has sought reconsideration of that holding. (*See* Markman Order, at 35:4-7). Any argument relating to *Halliburton* or Section 112, ¶ 6 is therefore *irrelevant* to the construction of "identification encoder."[9]

A recent Federal Circuit case makes clear that the breadth of a claim term is not indefiniteness. *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1340-1341 (Fed. Cir. 2005), *quoting, In re Gardner*, 427 F.2d 786, 788 (C.C.P.A. 1970) ("The test for indefiniteness does not depend on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention. . . . 'breadth is not indefiniteness.'").

Acacia also cited the M.P.E.P., which provides the same instructions to patent examiners. *See* M.P.E.P. § 2173.04, Seventh Edition, July 1998 ("Breadth of a claim is not to be equated with indefiniteness. [citation omitted]. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph").

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[9] Comcast further contends that the fact that Acacia is not contesting the Court's decision that "identification encoding means" (in claim 1 of the '992 patent) is indefinite means that "identification encoder" in the claims of the '702 patent must similarly be indefinite. This is a *non-sequiter*, because these two claim terms are construed under very different schemes. The term "identification encoding means" is construed according to Section 112, ¶ 6, which means that a structure corresponding to the claimed function must be found in the specification. The claimed functions are "retrieving the information in the items and assigning a a unique identification code to the retrieved information." No such requirement exists for "identification encoder," because this term is not construed under Section 112, ¶ 6 and these are not the functions recited in the claims which use the term "identification encoder."

Acacia also cited another M.P.E.P. section which instructs patent examiners that functional claim limitations are permitted:

> A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).
>
> A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

(M.P.E.P., § 2173.05(g), Seventh Edition, July 1998).

No defendant distinguished, or even mentioned, either the *Smithkline* case or either M.P.E.P. section in their opposition.

Defendants' arguments regarding functional claiming and broad claim constructions are also contrary to the holding of the Federal Circuit in numerous cases, including *Personalized Media*, *Phillips*, and *Lighting World*. Each of these cases supports Acacia's construction of "identification encoder" as "a structure that assigns a unique identification code."

In *Personalized Media*, like the present case, the court held that the claim term "digital detector" was sufficient structure to avoid application of Section 112, ¶ 6. *Personalized Media, LLC v. U.S. International Trade Comm.*, 161 F.3d 696, 705 (Fed. Cir. 1998) ("Even though the term 'detector' does not specifically evoke a particular structure, it does convey to one knowledgeable in the art a variety of structures known as 'detectors.' We therefore conclude that the term 'detector' is a sufficiently definite structural term to preclude the application of § 112, ¶ 6"). In construing the term "digital detector," the court found that the patent specification provided a broad meaning for "digital detector" as a "device" that performs a function:

> Here, the written description of the specification is sufficient to inform one skilled in the art of the meaning of the claim language "digital detector." It explicitly defines a "digital detector" as *a device* that "acts to detect the digital signal information" in another stream of information . . .

Personalized Media, 161 F.3d at 705-06 (emphasis added).

In *Phillips*, the *en banc* panel of the Federal Circuit held that the term "baffles" was sufficient structure in the claim to avoid the application of Section 112, ¶ 6. *Phillips*, 415 F.3d at 1311. In construing the term "baffle," the panel held that the intrinsic patent evidence confirms that the term "baffles" would have been understood by persons of skill in the art to have a *generic* meaning as an "object" that performs a function:

> Both parties, stipulating to a dictionary definition, also conceded that the term "baffles" refers to *objects* that check, impede, or obstruct the flow of something. The intrinsic evidence confirms that a person of skill in the art would understand that the term "baffles," as used in the '798 patent, would have that *generic meaning*.

Phillips, 415 F.3d at 1324 (emphasis added).

In *Lighting World*, the court held that the claim term "connector assembly" was sufficient structure to avoid the application of Section 112, ¶ 6. *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004) ("Thus, while it is true that the term 'connector assembly' does not bring to mind a particular structure, that point is not dispositive. What is important is whether the term is one that is understood to describe structure, as opposed to a nonce word or verbal construct that is not recognized as the name of structure and is simply a substitute for the term "means for.") The court construed the term "connector assembly" broadly to refer to a "unit" that performs a function:

> Thus, in the context of claim 1, the term "connector assembly" means *a unit* that joins, fastens, or links each pair of adjacent support members. The fact that more than one structure may be described by that term, or even that the term may encompass a multitude of structures, does not make the term "connector assembly" any less a name for structure.

Lighting World, 382 F.3d at 1361 (emphasis added).[10], [11]

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[10] *See also*, *Apex, Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1374 (Fed. Cir. 2003) (defining "interface circuit" as "any circuit that links one type of logic system with another.")

[11] In contrast to the Federal Circuit authority supplied by Acacia, defendants Comcast and EchoStar only cite the district court case of *Harrah's Entm't, Inc. v. Station Casinos*, 321 F.Supp. 2d 1173, 1179 (D. Nev. 2004). The *Harrah's* case is easily distinguished from the present case. In *Harrah's*, the claim term at issue was "theoretical win profile." This term did not refer to any structure; instead, the term refers to a mathematical value, which the plaintiff contended was computed using a three-part mathematical formula. *Harrah's*, 321 F.Supp. 2d at 1179. The court

Thus, according to the Federal Circuit precedent, it is correct to broadly construe a claim term which connotes structure, such as “identification encoder,” as being a structure for performing a particular function. In this case, if the term “identification encoder” is construed as “a structure that assigns a unique identification code,” more than just structure is included in this construction and Acacia would have to prove more than just structure for infringement (and defendants for invalidity). To prove infringement, Acacia would have to show *both* that the items in the accused transmission system have a unique identification code *and* prove that there is a structure in the accused transmission system that assigned that unique identification code. Defendants are wrong to contend that *any* structure could be an “identification encoder,” because it is *only* structures that assign “unique identification codes” (as that claim term was defined by the Court) that could be “identification encoders.”

The Court should therefore construe “identification encoder” as “a structure that assigns a unique identification code,” as this is how a person of ordinary skill in the art in 1991 when reading the claims in light of the specification would have understood was meant by the “identification encoder” and this is how other similar terms have been construed by the Federal Circuit under similar circumstances.[12]

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found the term “theoretical win profile” to be indefinite, because the patent did not “state how one might compute a theoretical win profile, or even consistently delineate whether it is a single number, or a large number of data points.” *Id.*

[12] Defendant Comcast contends that, because of the breadth of the term “identification encoder,” competitors could not ever know whether the limitation is met or whether the limitation is shown in the prior art. (Comcast Opposition, at 14:15 – 15:8). Comcast gives the example of the *Tindell* patent. During prosecution of the ‘702 patent, the Examiner cited *Tindell* as having an “identification encoder.” The Examiner relied on element number 46 of *Tindell* as being the “identification encoder.” Element 46 is shown in Figure 3 of *Tindell* as being an “encoder.” The specification describes element 46 as a device which encrypts the data for privacy purposes: “Compressed data is input to an encoder 46, which encrypts the data in order to preserve privacy.” (*Tindell*, 4:12-14). The scope of the identification encoder would be known from *Tindell*. An encoder that encrypts data, as described in *Tindell*, is not an “identification encoder,” because it does not assign a unique identification code.

III. CONCLUSION

For the reasons discussed above, the Court should reconsider its constructions of “identification encoder” and construe the “identification encoder” as “a structure that assigns a unique identification code.”

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